

REMARKS

Claims 10, 11, 15, 17, 18, 20-22, and 24-29 are pending in the present application. Claim 23 is hereby canceled. Claim 29 is new. Claims 10, 11, 21, 22, and 24-28 have been amended. Claims 10, 27, and 28 are independent claims. The Examiner is respectfully requested to reconsider the outstanding rejections in view of the above amendments and the following remarks.

Claim Objections

The Examiner objected to claims 10, 27, and 28, asserting that the preamble of these claims should be amended to recite a "computer-implemented method." Applicant has amended the claims accordingly. Therefore, this objection should be withdrawn.

Rejection Under 35 U.S.C. § 112

Claims 10, 27, and 28 stand rejected under 35 U.S.C. § 112, 2nd Paragraph, as being indefinite. Particularly, the Examiner asserts that the recitation of "the pixels" (line 6 of claim 10; line 5 of claim 27; line 5 of claim 28) lack sufficient antecedent basis in each of these claims. Further, the Examiner asserts that the recitation of "the additional context information" in claim 27 (line 19) lacks antecedent basis.

Claim 10 has been amended to provide sufficient antecedent basis for "the pixels." Further, claims 27 and 28 have been amended to provide sufficient antecedent basis for "the plurality of pixels," as now recited. Claim 27 has also been amended to remove "the additional content." Accordingly, Applicants submit that sufficient antecedent bases are provided for the features recited in claims 10, 27, and 28. Therefore, the Examiner is requested to withdraw this rejection.

Rejections Under 35 U.S.C. § 103

Claims 10, 20-22, and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0119762 to Denoue (hereafter “Denoue”) in view of U.S. Patent No. 7,042,594 to Dawe et al. (hereafter “Dawe”). Claim 27 stands rejected under § 103(a) as being unpatentable over Denoue and Dawe, and further in view of U.S. Patent Application Publication No. 2002/0076109 to Hertzfeld et al. Claim 28 stands rejected under § 103(a) as being unpatentable over Dawe in view of U.S. Patent Application Publication No. 2008/0046837 to Beauchamp et al. (hereafter “Beauchamp”) and Denoue.

The other claims currently depending on independent claim 10 have been rejected under § 103(a) based on Denoue and Dawe in combination with one or more of the following references: U.S. Patent No. 6,334,157 to Oppermann et al.; U.S. Patent Application Publication No. 2004/0135815 to Browne et al.; and U.S. Patent Application Publication No. 2003/0101156 to Newman.

These rejections, insofar as they pertain to the presently pending claims, are respectfully traversed. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). It is respectfully submitted that the applied references, taken separately or in combination, fail to teach or suggest each and every claimed feature.

As amended, independent claim 10 now recites the following features:

“... storing the captured pixels in an *image file* such that the image file is *representative of only those pixels of the display within the selected on-screen region*”(emphasis added).

Independent claims 27 and 28 have been amended to recite a similar feature:

“storing the captured pixels as an *image file* such that the image file is *representative of only those pixels of the display within the on-screen region*...”
(emphasis added).

As such, the independent claims require the captured pixels to be stored in an image file representative of only those pixels within the on-screen region. I.e., the claimed invention produces an image file representative of *only the captured pixels*. This feature is meaningful in that it allows for the captured content to be handled and process in certain ways which would not otherwise be allowed. For example, a user can share the captured content with other users by transmitting it as a file. As another example, the captured content may be provided with comment field(s) inherent to the particular file format. Other examples are discussed in the specification at paragraph 57.

None of the cited references teaches or suggests the particular claim feature producing an image file representing only the captured portion of the image. For instance, the Examiner acknowledges that Dawe “does not teach storing captured pixels such that the image file is representative of only those pixels of the display with the on-screen region” (Off. Act. at p. 17). The Examiner also admits that “Denoue does not explicitly teach storing captured data in an image file” (Off. Act. at p. 4, 4th paragraph). The Examiner does not even assert that any of the other references teach or suggest producing an image file (or any other type of file) just for the captured portion of an image.

Thus, the Examiner has failed to establish a *prima facie* case of obviousness because she has admittedly failed to provide a teaching or suggestion in any of the applied references of the claimed feature of storing the captured pixels in an image file representative of only those pixels.

While Applicants believe that the independent claims are allowable at least for the reasons set forth above, Applicants have further amended claims 10 and 28 to even further distinguish over the references, in an effort to expedite prosecution. Particularly, independent claim 10 has been amended to recite:

“*receiving a user command to annotate the one or more graphical elements [displayed within the on-screen region];*

in response to the user command, receiving an annotation drawn on the display by the user via the stylus” (emphasis added)

Similarly, claim 28 has been amended to recite:

receiving a user command to annotate the content displayed within the on-screen region;

in response to the user command, receiving an annotation drawn on the display by the user via the stylus” (emphasis added).

Such amendments are supported in, e.g., paragraph 49 of the specification, describing button selection as an exemplary type of user command for annotating captured content.

In rejecting claim 10, the Examiner asserts that Denoue teaches the claimed features of receiving the path drawn by the user via a stylus, capturing the pixels of the on-screen region defined by the path, and obtaining context information for the on-screen region by applying text recognition to an annotation drawn by the user (see Off. Act. at pp. 3-4). Particularly, the Examiner relies on the selection of graphical content from slide display 610 for the claimed selection of an on-screen region. Denoue teaches that this content can be pasted to user note display 620, and that other freeform notes 522 may also be added to this section (see paragraphs 0066 and 0069). Even assuming *arguendo* that such freeform notes could be interpreted as an annotation, there is no teaching or suggestion in Denoue that these freeform notes are received in response to receiving a user command to annotate the pasted graphical content. Thus, Denoue does not teach or suggest the aforementioned claim feature.

In rejecting claim 28, the Examiner relies on Beauchamp to teach receiving an annotation drawn on the display by the user via the stylus (see Off. Act. at p. 16). However, there is no teaching or suggestion in Beauchamp of selecting and capturing pixels in an on-screen region of the display. Thus, Beauchamp does not teach or suggest receiving a user command to annotate such an on-screen region receiving the user-drawn annotation. Accordingly, Beauchamp does not teach or suggest receiving the annotation in response to such a command.

Further, there is no teaching or suggestion in Dawe of receiving user-drawn annotations in response to first receiving a user command to annotate. In fact, according to Dawe's invention, annotations are only obtained from handwriting which are *part of the original image*, rather than

being drawn on the display by the user. Furthermore, none of the other references applied in the § 103 rejections teach or suggest receiving a user command to annotate a selected on-screen region.

As such, independent claims 10 and 28 are allowable for the additional reason that none of the applied references teaches or suggests receiving a user command to annotate the content displayed within the on-screen region and, in response thereto, receiving an annotation drawn by the user via the stylus from which context information is obtained.

At least for the reasons set forth above, Applicants respectfully submit that independent claims 10, 27, and 28 are allowable. Further, claims 11, 15, 17, 18, 20-22, and 24 are allowable at least by virtue of their dependency on an allowable independent claim. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

Conclusion

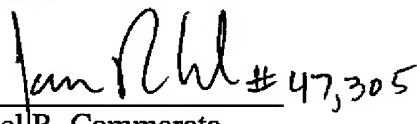
In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider the outstanding rejections and issue a Notice of Allowance in the present application.

Should the Examiner believe that any outstanding matters remain in the present application, the Examiner is respectfully requested to contact Jason W. Rhodes (Reg. No. 47,305) at the telephone number of the undersigned to discuss the present application in an effort to expedite prosecution.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: December 30, 2008

Respectfully submitted,

By  #47,305
for Michael R. Cammarata
Registration No.: 39,491
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant